

Amendments to the Claims

This listing of claims will replace all prior listings of claims in the application.

Listing of Claims

1. (Currently Amended) A colored, transparent film-forming composition ~~comprising~~ consisting of (a) a reaction product of an epoxy group-containing alkoxy silane (a-1) selected from the group consisting of γ -glycidoxypropyltrimethoxysilane, γ -glycidoxypropylmethyldimethoxysilane and γ -glycidoxypropyltriethoxysilane and an amino group-containing alkoxy silane ~~having active hydrogen therein~~ (a-2) selected from the group consisting of γ -aminopropyltrimethoxysilane, γ -aminopropyltriethoxysilane, N-(β -aminoethyl)- γ -aminopropyltrimethoxysilane, N-(β -aminoethyl)- γ -aminopropylmethyldimethoxysilane and N-(β -aminoethyl)- γ -aminopropyltriethoxysilane, (a-2) having active hydrogen therein and the weight ratio of (a-1) to (a-2) in the reaction is 6:4 to 9:1, (b) an acid catalyst, (c) an alkali-soluble UV absorber, (d) at least one organic solvent having a boiling point of 100 to 250°C, ~~and~~ (e) a dye and/or a pigment and, optionally, (f) a stabilizer selected from the group consisting of salicyclic acid, fumaric acid, crotonic acid, succinic acid, tartaric acid, and mixtures thereof.

2. (Cancelled)

3. (Currently Amended) ~~A~~The colored, transparent film-forming composition according to Claim 1, wherein the amino group-containing alkoxy silane ~~having active hydrogen~~ (a-2) consists of N-(β -aminoethyl)- γ -aminopropyltrimethoxysilane.

4. (Previously Presented) A colored, transparent film-forming composition according to Claim 1, wherein said at least one solvent is one or more members selected from the group consisting of alcohol solvents, ketone solvents, ether solvents and solvents having two or more functional groups.

5. (Currently Amended) A colored, transparent film-forming composition according to Claim 1, further ~~comprising~~containing (f) a stabilizer selected from the group consisting of salicylic acid, fumaric acid, crotonic acid, succinic acid, tartaric acid and mixtures thereof.

6. (Previously Presented) A colored, transparent film-forming composition according to Claim 1, wherein said alkali-soluble UV absorber is present in an amount of 5 to 40 wt% based on the film-forming components.

Claims 7-10 (Cancelled)

11. (Currently Amended) The colored, transparent film-forming composition according to Claim 1, wherein the amino group-containing alkoxy silane ~~having active hydrogen~~ (a-2) is one or more members selected from the group consisting of N-(β -aminoethyl)- γ -aminopropyltrimethoxysilane and N-(β -aminoethyl)- γ -aminopropylmethyldimethoxysilane.

12. (Previously Presented) The colored, transparent film-forming composition according to Claim 11, wherein the epoxy group-containing alkoxy silane (a-1) is one or more members selected from the group consisting of γ -glycidoxypropyltrimethoxysilane and γ -glycidoxypropylmethyldimethoxysilane.

REMARKS

In order to expedite the prosecution of the present application and place the claims in better form for consideration on appeal, the subject matter of Claims 2 and 10 have been incorporated into Claim 1 and the epoxy group-containing alkoxysilane (a-1) limited to being selected from the group consisting of γ -glycidoxypropyltrimethoxysilane, γ -glycidoxypropylmethyldimethoxysilane and γ -glycidoxypropyltriethoxysilane. Additionally, the amino group-containing alkoxysilane (a-2) has been limited to being selected from the group consisting of γ -aminopropyltrimethoxysilane, γ -aminopropyltriethoxysilane, N-(β -aminoethyl)- γ -aminopropyltrimethoxysilane, N-(β -aminoethyl)- γ -aminopropylmethyldimethoxysilane and N-(β -aminoethyl)- γ -aminopropyltriethoxysilane. Since these amendments result in the cancellation of claims, incorporate subject matter contained in dependent claims into independent Claim 1 and place the present application in better form for consideration on appeal, entry thereof is deemed proper under 37 CFR 1.116(b). Favorable consideration is respectfully solicited.

Claims 9 and 10 have been rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically speaking, the Examiner has rejected Applicants' "consisting essentially of" and "consisting off" language as being new matter. This rejection is clearly in error and not only do the examples in the present specification support "consisting essentially of" and "consisting of" language, Applicants have the right to narrow "comprising" language to "consisting essentially of" or "consisting of". If the Examiner maintains this rejection,

she is requested to provide support for the proposition that changing the language of a claimed combination of elements from "comprising" to "consisting essentially of" or "consisting of" is "new matter". In the absence of such support, and particularly in light of the examples in the present specification, the Examiner is respectfully requested to withdraw this rejection as it will not be upheld by the Board pending filing of an appeal brief.

Claim 2 has been rejected under 35 USC 112, second paragraph, as being indefinite. Once again, Applicants respectfully submit that one of ordinary skill in the art would be aware that the weight ratio is between the epoxy group-containing alkoxysilane and the amino group-containing alkoxysilane. However, in order to expedite the prosecution of the present application, the claims have been amended to recite that the weight ratio is between (a-1) and (a-2). Therefore, withdrawal of this rejection is respectfully solicited.

Claims 1, 3-6 and 9-12 have been rejected under 35 USC 102(b) as being anticipated by Nambu, et al. Claim 2 has been rejected under 35 USC 103(a) as being unpatentable over Nambu, et al. and further in view of Ramesh. Applicants respectfully traverse these Rules of rejection.

The current and claimed invention is directed to a colored, transparent film-forming composition consisting of (a) a reaction product of an epoxy group-containing alkoxysilane (a-1) selected from a group consisting of γ -glycidoxypropyltrimethoxysilane, γ -glycidoxypropylmethyldimethoxysilane and γ -glycidoxypropyltriethoxysilane and an amino group-containing alkoxysilane (a-2) selecting from the group consisting of γ -aminopropyltrimethoxysilane, γ -aminopropyltriethoxysilane, N-(β -aminoethyl)- γ -aminopropyltrimethoxysilane, N-(β -aminoethyl)- γ -aminopropylmethyldimethoxysilane and N-(β -

aminoethyl)- γ -aminopropyltriethoxysilane, with (a-2) having active hydrogen therein and the weight ratio of (a-1) to (a-2) in the reaction is 6:4 to 9:1, (b) an acid catalyst, (c) an alkali-soluble UV absorber, (d) at least one solvent selected from organic solvents having a boiling point of 100 to 250°C, (e) a dye and/or a pigment, and, optionally, (f) a stabilizer selected from the group consisting of salicylic acid, fumaric acid, crotonic acid, succinic acid, tartaric acid, and mixtures thereof.

As pointed out previously, the instant invention provides a colored, transparent film-forming composition which can be handled easily, forms an attractive, fashionable, transparent colored film article and can be easily removed or separated from a substrate. The film forming composition of the instant invention has a good leveling property without causing coating irregularities and can be cured at room temperature to provide a film that is free of color shading, high in film strength after curing and readily removable or separated from a substrate after extended use thereof.

In contrast with the presently claimed invention, the Nambu, et al. reference discloses a material having two coatings applied thereon. As discussed in the abstract of this reference, the first coating is obtained by applying a coat containing a metallic powder and/or a coloring pigment to a substrate and then a top coat clear coating is applied thereon. The top coat clear coating is made up of (A) a hydroxyl group-containing acrylic resin, an alkoxysilyl group-containing copolymer and a curing catalyst. At the outset, the dye and/or pigment referred to the Examiner as being disclosed at column 12, lines 64 and 65 and column 13, lines 1-24, are contained in the first coating applied to the substrate and are not contained in the top clear coating. Secondly, the Nambu, et al. reference does not disclose (a) a reaction product of an epoxy group-containing alkoxysilane (a-

1) and an amino group-containing alkoxysilane (a-2) having hydrogen therein. In the reaction taking place in the Nambu, et al. reference, a hydroxyl group-containing acrylic resin is present as a reactant. Assuming for argument sake that Nambu, et al. disclose the presently claimed components (a-1) and (a-2) as reactants, this reference still requires the presence of the hydroxyl group-containing acrylic resin in the reaction. As the Examiner is well aware, the reaction product of (a-1) and (a-2) is not the same as the reaction product of a hydroxyl group-containing acrylic resin and (a-1) and (a-2). Moreover, Nambu, et al. does not disclose N-(β -aminoethyl)- γ -aminopropylmethyldimethyl, which is said to be the same as (a-2) at column 2, lines 16 and 17 and column 11, lines 15-21, lines 25 and 26 and 39. Nambu, et al. discloses N-(β -aminoethyl)- γ -propyltrimethoxysilane).

In the present invention, the only polymers used are silicone-based polymers and polymers of non film-forming compositions. In contrast hereto, as pointed out above, Nambu, et al. requires the presence of a hydroxyl group-containing acrylic resin as the disclosure in all of the examples of this reference point out. As such, it is respectfully submitted that not only does Nambu, et al. not anticipate the presently patented invention, it does not even present a showing of prima facie obviousness under 35 USC 103 as it does not disclose the claimed reaction product between the epoxy group-containing alkoxysilane and amino group-containing alkoxysilane or a dye and/or a pigment and, additionally, the reaction product prepared in this reference utilizes a hydroxyl group-containing acrylic resin as a reactant, which is expressly excluded from the presently claimed invention.

The Ramesh reference discloses a cross-linker composition formed from combining an isocyanurate and a dicarboxylic acid cross-linking agent which are mixed with each other in a specific ratio. However, there is no disclosure contained in

this reference which would lead one of ordinary skill in the art to omit the critical hydroxyl group-containing acrylic resin from the reaction product of Nambu, et al. and add a dye and/or pigment to the clear topcoat coating of Nambu, et al. Therefore, it is respectfully submitted that the presently claimed invention clearly is patentably distinguishable over the combination of Ramesh with Nambu, et al.

Although the Examiner has not made a proper showing of prima facie absence under 35 USC 103(a) and the current rejections made by the Examiner would be reversed by the Board of Appeals on the currently presented record, Applicants are enclosing herewith a copy of a Declaration Under 37 CFR 1.132 in which products prepared according to the process of Nambu, et al. are compared with a product corresponding to Example A-2 of the present invention. As can be seen by the evidence contained in the enclosed Declaration under 37 CFR 1.132 and the samples enclosed therewith, commercial products ① and ② of Nambu, et al. are inferior to the product of the present invention. The executed 37 CFR 1.132 Declaration will be submitted to the Patent Office immediately after Applicant's representative receipt of same from Japan.

The Examiner is respectfully requested to reconsider the present application and to pass it to issue.

Respectfully submitted,


Terryence F. Chapman

TFC/ad

FLYNN, THIEL, BOUTELL
& TANIS, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1631
Phone: (269) 381-1156
Fax: (269) 381-5465

Dale H. Thiel	Reg. No. 24 323
David G. Boutell	Reg. No. 25 072
Ronald J. Tanis	Reg. No. 22 724
Terryence F. Chapman	Reg. No. 32 549
Mark L. Maki	Reg. No. 36 589
David S. Goldenberg	Reg. No. 31 257
Sidney B. Williams, Jr.	Reg. No. 24 949
Liane L. Churney	Reg. No. 40 694
Brian R. Tumm	Reg. No. 36 328
Robert J. Sayfie	Reg. No. 37 714

Encl: Unexecuted 37 CFR 1.132 Declaration
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